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October 21, 2002

Joseph M. Young

(Signature)

PATENT APPLICATION

ATTORNEY DOCKET NO. D/99341Q2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Myers

Application No.: 09/391,462
Filed: 9/8/99

Examiner: G. Clinton
Group Art Unit: 2154

Title: INTERACTIVE CONTEXT PRESERVED NAVIGATION OF GRAPHICAL DATA SETS USING MULTIPLE PHYSICAL TAGS

APPELLANTS' BRIEF ON APPEAL

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1. REAL PARTY OF INTEREST

The real party in interest in the present Appeal is Xerox Corporation, the assignee, as evidenced by the assignment set forth at Reel 010424, Frame 0474.

2. RELATED APPEALS AND INTERFERENCES

It is believed that there are no related appeals and interferences.

3. STATUS OF CLAIMS

Claims 1-9 stand finally rejected. Appellants withdraw claim 9 from consideration.

4. STATUS OF AMENDMENTS

The Examiner stated that the amendment dated July 1, 2002 would not be entered because it does not place the case in condition for allowance. Appellants submitted the Notice of Appeal and Appeal fee on August 21, 2002.

5. SUMMARY OF INVENTION

The present invention is directed towards using physically distinct electronic tags to navigate interactive digital environments to provide digital navigation services of N-space data sets in response to reading the unique identifier of each electronic tag.

In disclosed embodiments, a system 10 for N-space navigation of digital data sets includes identifying multiple electronic tags generally having a locally unique electronically readable digitally or optically readable identification number and providing various digital navigation services in response electronic tag reading systems 16. In described embodiments, the electronic tag reader systems can be based on temporary direct connections between the tag and a computing system. Alternatively, the electronic tag can be read by the electronic tag reader through a wireless connection. Tag reading system 16 can include radio frequency based systems 20, magnetic strip card based systems 32, infrared based systems 40, or optical character/bar code based systems 46. Such electronic tag systems allow for access to digital

navigation systems 14, by use of respective electronic tag readers 22, 34, 42, and 48) connected to a computing system 12, which may include a local embedded, handheld or desktop computer, database servers, and networked computers. When electronic tags 26, 36, 44, or 50 are brought near suitable tag readers, information is read from the electronic tags and the locally unique identification number of the electronic tag is passed to the computing system 12, which in turn mediates navigational control of systems 14. (Specification, page 2, lines 1-8; page 7, lines 12-26).

Digital navigation systems 14 can include, but are not limited to, navigational control of audio data systems 60; navigational control of video data systems 62; centering on a preferred coordinate axis from a predefined viewpoint for navigation of static 2-dimensional data display systems 64; object centered movable viewpoint for "flyby" tracking of rendered 3-dimensional objects in rendered 3-dimensional graphical viewing systems 66; or control of physical or optical (e.g. holographic) 3-dimensional viewing systems 68. (Specification, page 7, lines 27 through page 8, line 6)

In described embodiments, the digitally readable identifier of the electronic tag can be premarked with suitable graphical, symbolic, or textual indicia and pre-associated with a predetermined digital navigation service. In addition, the tag can be shape or texturally coded for ease of recognition. Alternatively, an electronic tag can be color coded or marked with text by a user to aid in remembering an interactive association of the electronic tag with a defined digital navigation anchor or service. (Specification, page 2, lines 9-18).

Each identification number or sensed data value that is read by the tag reader can be labeled as a "command," with a particular digital service or attribute being associated with each command. (Specification, page 4, lines 18-21; page 12, lines 4-7) Once the identification number is received, the tag reader passes this on to a computer system. Upon receipt of the identification number, the computing system interprets the identification input string, determines the current application navigational context, and provides appropriate digital services. (Specification, page 4, lines 5-7; page 10, lines 19-21). One common action is a {program, navigational viewpoint} pair that invokes the identified program at an

associated navigational viewpoint. If the received navigational viewpoint has not been previously registered, i.e. associated with an action in the ASCII database, the user can be prompted to enter associated parameters via a dialog box. Alternatively, in certain preferred embodiments users navigate to the desired location, move a previously unregistered tag past a reader, and allow electronic tag data to be automatically set to the displayed location. (Specification, page 4, lines 10-17)

Sequences of static images such as documents can also be navigated using the present invention. For example, an electronic tag can act as an electronic bookmark that allows a user to directly bring up a desired page. (Specification, page 7, lines 2-4)

In described embodiments, tags 28 can have a user writable surface 30 for preapplied or user applied marking. (Specification, page 4, lines 23-25)

6. ISSUES

Was Claim 9 improperly rejected under the judicially created doctrine of obviousness-type double patenting of claim 1 of U.S. Patent No. 6,340,931 (the '931 patent)?

Were Claims 1, 2, and 4-9 improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,342,830 to Want et al. (the '830 patent) in view of U.S. Patent No. 6,222,557 to Pulley et al. (the '557 patent)?

Were Claims 1 and 3-8 improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,249,212 (the '212 patent) to Beigel et al. in view of U.S. Patent No. 5,847,709 (the '709 patent) to Card et al.?

7. GROUPING OF CLAIMS

The claims do not all stand or fall together. The claims are classified as follows:

Group I - claims 1, 4, and 6-8.

Group II - claim 2.

Group III - claim 3.

Group IV - claim 5.

Claim 9 is withdrawn from appeal

8. ARGUMENT

A) Claim 9 was improperly rejected under the judicially created doctrine of obviousness-type double patenting of claim 1 of U.S. Patent No. 6,340,931 (the '931 patent).

The rejection is moot as claim 9 has been withdrawn. However, Appellants maintain that the double patenting rejection was improper. However, upon closely analyzing the '931 patent, Appellants have discovered that the Examiner should have made a 35 U.S.C. § 102(e) rejection

B) Claims 1, 2, and 4-9 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,342,830 to Want et al. (the '830 patent) in view of U.S. Patent No. 6,222,557 to Pulley et al. (the '557 patent).

Group I - (claims 1, 4, and 6-8)

The Board should reverse the Examiner with respect to claim 1 as the Examiner has failed to establish that claim 1 is unpatentable over U.S. Patent No. 6,342,830 to Want et al. (the '830 patent) in view of U.S. Patent No. 6,222,557 to Pulley et al. (the '557 patent).

In claim 1, Appellants recite a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one

transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. While Appellants do not acknowledge disclosure of the elements of the claimed invention by the references, Appellant s submit that the Examiner has not identified any suggestion in any of the references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). This suggestion must be found in the prior art, and cannot be based upon Appellants' disclosure. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 1. The Examiner has stated that it would be obvious to combine the disclosures of the '830 and '557 patents to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either the '830 patent, the '557 patent or the prior art in general that suggests that an electronic tag, an electronic tag reader, and a computing system as disclosed in the '830 patent should be combined with the navigation system and method of viewing a data landscape in an information visualization system disclosed in the '557 patent to achieve Appellants' claimed invention.

The Examiner claims to recognize that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. However, the Examiner has appeared to overlook the admonition that this teaching cannot come from Appellants' disclosure. The Examiner states, "A person of ordinary skill in the art, seeing the advantages Want's invention provides with respect to input devices, would have been motivated to combine it and Pulley's graphical navigation system to create an intuitive and flexible method for navigating a flexible N-space." Appellants ask why? The Examiner has asserted that a person skilled in the art could combine these references, but he has provided no reason why they would. This is impermissible.

Recently, the Court of Appeals for the Federal Circuit (CAFC) addressed this issue in in re Lee 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed Cir. 2002).

In Lee, the Examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference described a television set having a menu display by which the user can adjust various picture and audio functions. However, the Nortrup display did not include a demonstration of how to adjust the functions. The Thunderchopper Handbook described the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game. However, the Thunderchopper Handbook made no mention of the adjustment of picture or audio functions. The Examiner held that it would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system. Lee appealed to the Board of Patent Appeals and Interferences (Board), arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Nortrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated, "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art

without any specific hint or suggestion in a particular reference." The CAFC reversed the Board stating,

> When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. . . . With respect to Lee's application, neither the Examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described.
> Lee 277 F.3d 1343.

As in Lee, the Examiner of the application on Appeal has failed to establish that the references suggest the desirability of the invention disclosed in either claim 1. The Examiner has stated that it would be obvious to combine the disclosures of the '830 patent and the '557 patent to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either patent, or in the prior art in general, that suggests that the system for identifying multiple electronic tags of the '830 patent should be combined with the navigational method and system for viewing a 3D data landscape of the '557 patent to achieve Appellants' claimed invention.

More precisely, there are two scenarios by which one skilled in the art might be motivated to combine the disclosures of the '830 patent and the '557 patent. The Examiner has not argued either of these.

First, the Examiner has not shown that the '830 patent discloses or suggests in any manner navigation of any type of space. The '830 patent discloses an electronic tag, a tag reader, and a computing system connected to the electronic tag reader for providing digital services. The Examiner has not pointed to the slightest hint that anyone in possession of the '830 patent would ever think about navigating virtual spaces. The Examiner has asserted no reason why adding the navigational method and system of the '557 patent to the disclosure of the '830 patent would improve or enhance the '830 patent..

Second, the '557 patent discloses a navigation system and method for viewing a 3D data landscape. The user provides input through a keyboard and a mouse. By entering input, the viewpoint within the data landscape changes. The Examiner has asserted no reason why one in possession of the '557 patent would be motivated to replace the mouse and keyboard of the '557 patent with the tag and tag reader of the '830 patent. In fact, an electronic tag and tag reader would probably add to the expense and complexity of '557 patent

The combination of these two patents appears to be nothing more than hindsight reconstruction on the part of the Examiner. The Examiner has set forth no reason why anyone would combine these references other than to create Appellants' invention. Without more, this is impermissible.

The Examiner may also be of the position that the invention claimed in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. §103. In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); In re Yates, 211 U.S.P.Q. 1149 (CCPA 1981); In re Goodwin, 576 F.2d 375, 198 U.S.P.Q. 1 (CCPA 1978).

For the foregoing reasons, the Board should reverse the Examiner and allow claim 1. As claims 4 and 6-8 depend from claim 1, the Board should also allow claims 4 and 6-8.

Group II - (Claim 2)

The Board should reverse the Examiner with respect to claim 3 as the Examiner has failed to establish that claim 3 is unpatentable over U.S. Patent No. 6,342,830 to Want et al. (the '830 patent) in view of U.S. Patent No. 6,222,557 to Pulley et al. (the '557 patent).

In claim 2, Appellants recite a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space graphical data sets in response to reading the identifier of the electronic tag, with the computing system generating

at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Claim 2 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 2. The Examiner has stated that it would be obvious to combine the disclosures of the '830 and '557 patents to achieve the invention recited in claim 2. However, the Examiner has pointed to nothing in either the '830 patent, the '557 patent or the prior art in general that suggests that an electronic tag, an electronic tag reader, and a computing system as disclosed in the '830 patent should be combined with the navigation system and method of viewing a data landscape in an information visualization system disclosed in the '557 patent to achieve Appellants' claimed invention.

Appellants have already argued with respect to claim 1 that point to a motivation or suggestion to combine the references. Every argument made with respect to claim 1 equally applies to claim 2.

Further, claim 2 discloses navigation of graphical data sets. The Examiner has not pointed to a relevant portion of the '830 patent suggesting navigation of graphical data. Therefore, there would be even less motivation to combine the disclosure of the '557 patent with that of the '830 patent.

Group IV - (Claim 5)

The Board should reverse the Examiner with respect to claim 5 as the Examiner has failed to establish that claim 5 is unpatentable over U.S. Patent No. 6,342,830 to Want et al. (the '830 patent) in view of U.S. Patent No. 6,222,557 to Pulley et al. (the '557 patent).

In claim 1, Appellants recite a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, the electronic tag having a surface for user defined annotation, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the

electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Claim 5 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 5. The Examiner has stated that it would be obvious to combine the disclosures of the '830 and '557 patents to achieve the invention recited in claim 5. However, the Examiner has pointed to nothing in either the '830 patent, the '557 patent or the prior art in general that suggests that an electronic tag, an electronic tag reader, and a computing system as disclosed in the '830 patent should be combined with the navigation system and method of viewing a data landscape in an information visualization system disclosed in the '557 patent to achieve Appellants' claimed invention.

Appellants have already argued with respect to claim 1 that point to a motivation or suggestion to combine the references. Every argument made with respect to claim 1 equally applies to claim 5.

Further, claim 5 recites a surface for user defined annotation. The Examiner seeks to add to the combination official notice of credit cards, which include a surface for user defined annotation, i.e., a signature line. Appellants again argue why anyone not in possession of Appellants' invention would seek to combine these references. Not only has the Examiner not provided any motivation for combining the disclosures of the '830 patent and the '557 patent, he has also provided no suggestion or motivation as to why one skilled in the art would wish to combine these references with the details of a credit card.

C) Claims 1 and 3-8 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,249,212 to Beigel et al. (the '212 patent) in view of U.S. Patent No. 5,847,709 to Card et al. (the '709 patent).

Group I - (claims 1, 4, and 6-8)

The Board should reverse the Examiner with respect to claim 1 as the Examiner has failed to establish that claim 1 is unpatentable over U.S. Patent No. 6,249,212 to Biegel et al. (the '212 patent) in view of U.S. Patent No. 5,847,709 to Card et al. (the '709 patent).

Claim 1 recites a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Again, claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). This suggestion must be found in the prior art, and cannot be based upon Appellants' disclosure. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

While Appellants do not acknowledge disclosure of the elements of the claimed invention by the references, Appellants submit that the Examiner has not identified any suggestion in any of the references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 1. The Examiner has stated that it would be obvious to combine

the disclosures of the '212 and '709 patents to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either the '212 patent, the '709 patent or the prior art in general that suggests that the electronic tag and electronic tag reader of the '212 patent should be combined with the computing system providing digital navigation services disclosed in the '709 patent to achieve Appellants' claimed invention.

The Examiner claims to recognize that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, again the Examiner has appeared to overlook the admonition that this teaching cannot come from Appellants' disclosure. The Examiner states,

> A person of ordinary skill in the art would have realized that the tag and reader of Beigel would provide advantages similar to those provided by Want. Similarly, the person of ordinary skill in the art would have realized that the invention of Card requires an input device to operate (Card, Figure 1, reference characters 104 and 106, disclosing a keyboard and a cursor control device.) Thus a person of ordinary skill in the art, seeing the advantages Beigel's invention provides with respect to input devices, would have been motivated to combine it and Card's graphical navigation system to create an intuitive and flexible method for navigating a document data set.

The Examiner has asserted that a person skilled in the art could combine these references, but he has provided no reason why they would. This is impermissible.

Recently, the Court of Appeals for the Federal Circuit (CAFC) addressed this issue in in re Lee 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed Cir. 2002).

In Lee, the Examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference described a television set having a menu display by which the user can adjust various picture

and audio functions. However, the Nortrup display did not include a demonstration of how to adjust the functions. The Thunderchopper Handbook described the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game. However, the Thunderchopper Handbook made no mention of the adjustment of picture or audio functions. The Examiner held that it would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system. Lee appealed to the Board of Patent Appeals and Interferences (Board), arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Nortrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated, "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." The CAFC reversed the Board stating,

> When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. . . . With respect to Lee's application, neither the Examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described.
> Lee 277 F.3d 1343.

As in Lee, the Examiner of the application on Appeal has failed to establish that the references suggest the desirability of the invention disclosed in either claim 1. The Examiner has stated that it would be obvious to combine the disclosures of the '212 patent and the '709 patent to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either patent, or in the prior art in general, that suggests that the universal

electronic identification tag of the '212 patent should be combined with the three dimensional document workspace of the '709 patent to achieve Appellants' claimed invention.

More precisely, there are two scenarios by which one skilled in the art might be motivated to combine the disclosures of the '212 patent and the '709 patent. The Examiner has not argued either of these.

First, the Examiner has not shown that the '212 patent discloses a computing system for the navigation of any dimensional space. The '212 patent appears to be concerned with simply being able to identify a tag with a variety of readers. The Examiner has not pointed to the slightest hint that anyone in possession of the '212 patent would ever think about navigating virtual spaces. The Examiner has asserted no reason why adding the three-dimensional document workspace of the '709 patent to the disclosure of the '212 patent would improve or enhance the '212 patent.

Second, the '709 patent discloses a three-dimensional document workspace and a system for moving documents within the workspace. The user provides input through a keyboard or a cursor control device. By providing input to through the cursor control device or keyboard a user can move a document within the document workspace. The Examiner has asserted no reason why one in possession of the '709 patent would be motivated to replace the mouse and keyboard of the '709 patent with the tag and tag reader of the '212 patent. In fact, an electronic tag and tag reader would probably add to the expense and complexity of the display system of the '709 patent

The combination of these two patents appears to be nothing more than hindsight reconstruction on the part of the Examiner. The Examiner has set forth no reason why anyone would combine these references other than to create Appellants' invention. Without more, this is impermissible.

The Examiner may also be of the position that the invention claimed in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. §103. In re

Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); In re Yates, 211 U.S.P.Q. 1149 (CCPA 1981); In re Goodwin, 576 F.2d 375, 198 U.S.P.Q. 1 (CCPA 1978).

For the foregoing reasons, the Board should reverse the Examiner and allow claim 1. As claims 4 and 6-8 depend from claim 1, the Board should also allow claims 4 and 6-8.

Group III - (claim 3)

The Board should reverse the Examiner with respect to claim 3 as the Examiner has failed to establish that claim 3 is unpatentable over U.S. Patent No. 6,249,212 to Biegel et al. (the '212 patent) in view of U.S. Patent No. 5,847,709 to Card et al. (the '709 patent).

Claim 3 recites a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space document data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Claim 3 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 3. The Examiner has stated that it would be obvious to combine the disclosures of the '212 and '709 patents to achieve the invention recited in claim 3. However, the Examiner has pointed to nothing in either the '212 patent, the '709 patent or the prior art in general that suggests that the electronic tag and electronic tag reader of the '212 patent should be combined with the computing system providing digital navigation services disclosed in the '709 patent to achieve Appellants' claimed invention.

Appellants have already argued with respect to claim 1 that point to a motivation or suggestion to combine the references. Every argument made with respect to claim 1 equally applies to claim 3.

Further, claim 3 recites navigation of document data sets. The Examiner has not pointed to a relevant portion of the '212 patent suggesting navigation of document data. Therefore, there would be even less motivation to combine the disclosure of the '709 patent with that of the '212 patent.

Group IV - (claim 5)

The Board should reverse the Examiner with respect to claim 3 as the Examiner has failed to establish that claim 3 is unpatentable over U.S. Patent No. 6,249,212 to Biegel et al. (the '212 patent) in view of U.S. Patent No. 5,847,709 to Card et al. (the '709 patent).

In claim 1, Appellants recite a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, the electronic tag having a surface for user defined annotation, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Claim 5 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 5. The Examiner has stated that it would be obvious to combine the disclosures of the '212 and '709 patents to achieve the invention recited in claim 5. However, the Examiner has pointed to nothing in either the '212 patent, the '709 patent or the prior art in general that suggests that the electronic tag and electronic tag reader of the '212 patent should be combined with the computing system providing digital navigation services disclosed in the '709 patent to achieve Appellants' claimed invention.

Appellants have already argued with respect to claim 1 that point to a motivation or suggestion to combine the references. Every argument made with respect to claim 1 equally applies to claim 5.

Further, claim 5 recites a surface for user defined annotation. The Examiner seeks to add to the combination official notice of credit cards, which include a surface for user defined annotation, i.e., a signature line. Appellants again argue why anyone not in possession of Appellants' invention would seek to combine these references. Not only has the Examiner not provided any motivation for combining the disclosures of the '212 patent and the '709 patent, he has also provided no suggestion or motivation as to why one skilled in the art would wish to combine these references with the details of a credit card.

D) Response to Examiner's Comments in Advisory Action

The following arguments are made in response to the Examiner's statements in his Advisory Action dated 5 July 2002.

Regarding the Examiner's statement that Appellant cannot attack references individually where the rejections are based upon combinations of references, the Examiner is correct. However, Appellants made no such attacks. Appellants were simply trying to show the complete lack of motivation one skilled in the art would have had to combine these references (without the concept of Appellants' invention). Appellants were simply pointing out that the Examiner had pointed to no part of either patent suggesting any sort of navigational behavior.

Regarding the Examiner's assertion that a tag/tag reader is substitutable for a mouse/keyboard, the argument is glib at best. In a general sense both are methods of entering data into a system. However, the characteristics, operability, and methods of entry are sufficiently different that Appellants wonder how anyone could arrive at the conclusion that they are easily substitutable. Appellants visualize drafting a document by scanning in one word at a time out of a dictionary or perhaps moving a tag around a room to move a cursor about on a screen. The navigation system of the '557 patent involves manipulating data in a file. The idea that going through all the expense of representing data with physical objects, and then manipulating those physical tags certainly seems in many cases to be less desirable than simply typing data in through a keyboard.

Accordingly, the Examiner has not established a prima facie case of obviousness. Thus, the Board of Appeals is respectfully urged to reverse all of the Examiner's rejections.

Respectfully submitted,

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9. APPENDIX:

The following are the appealed claims:

1. A system for N-space navigation of digital data sets, the system comprising

an electronic tag having a digitally readable identifier

an electronic tag reader configured to read the identifier of the electronic tag,

a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

2. (Amended) The system of **claim 1**, wherein the N-space data set is a graphical data set.

3. The system of **claim 1**, wherein the N-space data set is a document data set.

4. The system of **claim 1**, wherein the electronic tag is premarked.

5. The system of **claim 1**, wherein the electronic tag presents a surface for user defined annotation.

6. The system of **claim 1**, wherein the electronic tag is read by the electronic tag reader through a wireless connection.

7. The system of **claim 6**, wherein the wireless connection operates at radio frequencies.

8. The system of **claim 6**, wherein the wireless connection is infrared.

9. A method for N-space navigation of digital data sets, the method comprising the steps of

first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a first default navigational action,

second reading within a determined duration of the first reading step a second electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a second default navigational action.